

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Lykos

Mailed: March 18, 2003

Opposition No. 119,899

Duramax Marine, LLC

v.

R.W. Fernstrum & Company

Angela Lykos, Interlocutory Attorney

On March 12, 2003, counsel for applicant contacted the Board regarding the possibility of having a telephone conference for this case. Counsel stated that the parties were at an impasse regarding whether opposer's document production requests were timely served. On that same day, the Board granted counsel's request for a phone conference. Counsel for applicant contacted counsel for opposer to schedule a mutually agreeable time for holding the telephone conference.

At the Board's request, on March 13, 2003, counsel for applicant submitted via facsimile a written agenda for the telephone conference to clarify the issues to be discussed. The Board interprets applicant's agenda as a motion for protective order in response to opposer's written discovery

requests. After reviewing applicant's agenda, the Board requested that applicant provide copies of all notices of depositions and attached document production requests at issue, which were submitted via facsimile on March 14, 2003. The Board determined that additional written briefing would be unnecessary.

The conference was held at 2 PM EST, on Monday, March 17, 2003 among Mark A. Bergsman, counsel for applicant, and D. Peter Hochberg, counsel for opposer, and the undersigned, substituting for the Board attorney responsible for resolving interlocutory disputes in this proceeding.

By way of relevant background, on October 15, 2001, opposer noticed the depositions of Paul W. Fernstrum, Todd S. Fernstrum, Sean W. Fernstrum. According to the record, and as confirmed by the parties during the telephone conference, these deposition notices did not include any document production requests pursuant to Rule 30(b)(5). On that same date, opposer also noticed a deposition pursuant to Rule 30(b)(6) with a request contained therein that applicant bring to the deposition responses to "Opposer's Request for Production of Documents" previously served under Rule 34. During the telephone conference, counsel for applicant clarified that this document production request referred to "Opposer's First Set of Interrogatories and Initial Request for Production of Documents to Applicant"

served on August 1, 2001, and responded to by applicant on September 4, 2001.¹

On February 5, 2003, the Board issued an order in this proceeding in which it decided numerous discovery motions, and provided for an abbreviated discovery period, which is scheduled to open on April 24, 2003 and close on April 30, 2003. In its order, the Board made the following rulings:

(1) denied opposer's motion to enter applicant's property to inspect documents on applicant's premises pursuant to Rule 34(a)(2); denied opposer's motion to compel the attendance of Paul Fernstrum as applicant's 30(b)(6) witness; denied opposer's motion to compel Paul Fernstrum's attendance for a discovery deposition in Michigan on a date when he does not reside in Michigan; and denied opposer's motion to stay the depositions of Paul Fernstrum, Sean Fernstrum, Todd Fernstrum, and its 30(b)(6) witness pending a Rule 34(a)(2) inspection; allowed opposer thirty days to re-notice the depositions of Paul W. Fernstrum, Todd S. Fernstrum, Sean W. Fernstrum and a Rule 30(b)(6) witness(es) to take place during one of the six days in the discovery period;

(2) denied opposer's motion to extend discovery, and to the extent that opposer seeks a stay of discovery, the Board

¹ At the Board's request, evidence thereof was submitted following the telephone conference on March 17, 2003.

provided for an abbreviated six day discovery period;

(3) denied opposer's motion to compel answers to its third and fourth set of interrogatories;

(4) granted applicant's motion to compel opposer to produce two documents;

(5) denied opposer's motion to test the sufficiency of applicant's responses to opposer's fifth set of requests for admissions;

(6) denied opposer's motion to compel responses to its first and second set of document production requests and interrogatories.²

In accordance with the terms of the Board order, on March 7, 2003, opposer noticed the depositions of Sean W. Fernstrum, Todd S. Fernstrum, Dale Gusick and Frank Bjorkman, as well as a witness(es) pursuant to Rule 30(b)(6). Each of the deposition notices were accompanied by a request for production of documents pursuant to Rules 30(b)(5) and 34. Following several telephone conversations and e-mail exchanges, the parties agreed to schedule the depositions to take place outside of the discovery period, namely, the deposition of Paul Fernstrum to take place on April 22, 2003 and the remaining depositions to take place during the week of April 14, 2003.

² The Board allowed applicant time, however, to supplement its responses to document requests No. 1 and interrogatories No. 11 (a).

Applicant essentially argued that it agreed to opposer's requests to schedule the depositions outside the Board's specified discovery period in an effort to accommodate opposer's schedule; that this agreement pertained only to deposition examinations and did not include any written discovery requests under Rule 30(b)(5) and Rule 34; and that inasmuch as the discovery requests were served outside the discovery period, they are untimely.

In response, counsel for opposer maintains that in reaching the agreement to reschedule the depositions, while the parties only discussed dates, he assumed that the agreement encompassed the aforementioned document production requests; and that the documents produced by applicant in response to opposer's prior document production requests have been inadequate because they mostly comprise easy to obtain publicly available documents.

After careful consideration of the parties' arguments and a review of the record, the Board deems opposer's written discovery requests as premature because discovery has not yet re-opened, and grants applicant's motion for protective order. In comparing all of the notices of deposition originally served on October 15, 2001 by opposer on applicant with the more recent deposition notices served March 7, 2003, none of the original deposition notices contained document production requests pursuant to Rule

30(b)(5). Furthermore, as noted above, the document production request referred to in the Rule 30(b)(6) deposition notice was opposer's first request for documents which applicant has responded to; the Board has denied opposer's motion to compel further responses thereto. To the extent, if any, that opposer is unsatisfied with applicant's current responses and is attempting to circumvent the Board's denial of its motion to compel by attaching extensive document production requests to the newly noticed depositions pursuant to Rule 30(b)(5), it cannot do so.

To further clarify matters, in this particular case, the Board's intent in providing for an abbreviated discovery period set in advance was to accommodate scheduling issues on the part of the parties for depositions and to allow the same time that was remaining in the trial schedule prior to the filing of the motion to compel for the parties to take any follow-up discovery. While opposer's contention that a party may request that a noticed deponent produce documents under Rule 30(b)(5) is generally true insofar as when discovery is open at the time a deposition is being noticed, in this particular instance, the discovery period is now closed.

The Board reminds the parties of the good faith effort requirements set forth in Trademark Rule 2.120 and *Sentrol*,

Inc. v. Sentex Systems, Inc., 231 USPQ 666 (TTAB 1986).

That is, the parties must cooperate with each other so that the case may proceed in an orderly manner within reasonable time constraints.

In summary, applicant's motion for protective order is granted. Applicant is not required to produce any documents pursuant to Rules 30(b)(5) and 34 in connection with the depositions scheduled to take place in April.

Trial dates, including the opening and closing of the discovery period, remain as set in the Board's February 5, 2003 order.

The Board thanks counsel for opposer for agreeing to participate in the phone conference and counsel for applicant for requesting the conference.

Finally, the Board is forwarding this order by facsimile transmission and by first class mail.